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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,208	01/14/2004	Joseph W. Coburn JR.	15254C	3568

7590

05/02/2005

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/757,208	<b>Applicant(s)</b> COBURN, JOSEPH W./	
	<b>Examiner</b> Patricia L. Nordmeyer	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*u*

## **DETAILED ACTION**

### ***Withdrawn Rejections***

1. The 35 U.S.C. 103 rejection of claims 1 – 10 over Futhey et al. in view of Tackikawa et al. in the paper dated May 28, 2004 is withdrawn due to Applicant's arguments presented in the paper dated June 10, 2004.
2. The 35 U.S.C. 103 rejection of claims 11 and 12 over Futhey et al. in view of Tackikawa et al. and Martin in the paper dated May 28, 2004 is withdrawn due to Applicant's arguments presented in the paper dated June 10, 2004.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 6 and 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Bonkowski et al. (USPN 6,761,959).

Bonkowski et al. discloses a layer of transparent polymeric material having opposed

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surfaces (Column 4, lines 15 – 16 and 41 – 54; and Figure 1A, #14), one of said opposed surface provided with a plurality of parallel ridges and grooves, said ridges being parallel ridges formed by facets defining a convex surface joined by surfaces forming steps connecting the adjacent facets (Figure 1, #14; Column 4, 25 – 32) with an outer layer of substantially transparent color effect producing material mounted to one of said opposed surfaces (Column 4, lines 17 – 20) wherein said layer of transparent polymeric material and said layer of substantially transparent color effect producing material combining to produce in the presence of light a color effect image such that said layer of transparent polymeric material has an appearance other than that of a surface of said layer of transparent polymeric material and said image being other coincident with said opposed surfaces (Column 4, lines 57 – 59) and a layer of product mounting adhesive applied to the opposed surface of said material to which said layer of substantially transparent color effect producing material is not mounted (Column 9, line 63; Figure 8, #66) as in claim 1. With regards to claim 2, the layer of substantially color effect producing material is a layer of substantially transparent colored polymeric material (Column 7, lines 66 to Column 8, line 2). As in claim 6, the layer of substantially transparent color effect producing material is a layer of substantially transparent iridescent material and wherein said layer of transparent polymeric material and said layer of substantially transparent iridescent material produce in the presence of light a color effect image which is an iridescent color effect image (Column 1, lines 30 – 36). The ridges and grooves are coated with a layer of reflective metallic material (Figure 2B, #18; and Column 5, lines 3 – 14) as in claim 8.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 – 5, 7 and 9 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonkowski et al. (USPN 6,761,959).

Bonkowski et al. discloses a layer of transparent polymeric material having opposed surfaces (Column 4, lines 15 – 16 and 41 – 54; and Figure 1A, #14), one of said opposed surface provided with a plurality of parallel ridges and grooves, said ridges being parallel ridges formed by facets defining a convex surface joined by surfaces forming steps connecting the adjacent facets (Figure 1, #14; Column 4, 25 – 32) with an outer layer of substantially transparent color effect producing material mounted to one of said opposed surfaces (Column 4, lines 17 – 20) wherein said layer of transparent polymeric material and said layer of substantially transparent color effect producing material combining to produce in the presence of light a color effect image such that said layer of transparent polymeric material has an appearance other than that of a surface of said layer of transparent polymeric material and said image being other coincident with said opposed surfaces (Column 4, lines 57 – 59) and a layer of product mounting adhesive applied to the opposed surface of said material to which said layer of substantially transparent color effect producing material is not mounted (Column 9, line 63; Figure 8, #66). As in claim 10, the substantially transparent color effect producing material is mounted to said opposed

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surface provided with said plurality of ridges and grooves (Figure 7, #16) and said layer product mounting adhesive is applied to said smooth opposed surface (Figure 7, #62). With claim 12, the substantially transparent color effect producing material is mounted to said smooth surface (Figure 5, #16) and said layer product mounting adhesive is applied to said opposed surface (Figure 5, #62). However, Bonkowski et al. fail to disclose said layer of substantially transparent colored polymeric material is mounted to said one of said opposed surfaces by a layer of substantially transparent adhesive, substantially transparent adhesive is a layer of substantially colored transparent adhesive, said substantially colored adhesive is a layer of substantially clear colored adhesive of the same color as said layer of substantially transparent colored polymeric material, said layer of substantially transparent iridescent material is mounted to said one of said opposed surfaces by a layer of substantially transparent adhesive and said layer of substantially transparent colored polymeric material is mounted to said opposed surfaces provided with said plurality of plurality of ridges and grooves by a layer of substantially transparent adhesive.

Regarding the use of a substantially transparent adhesive to adhere the layers of the decorative product together in claims 3 – 5, 7 and 9 – 12, Bonkowski et al. discloses the claimed invention except for the use of a substantially transparent adhesive to adhere the layers of the decorative product together. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an adhesive material to place the layers together in the desired order instead of using the method of sputtering or physical vapor deposition (Column 3, lines 65 – 67; Column 5, lines 15 – 17) as disclosed by Bonkowski et al., since it has been held that omission of an element and its function in combination where the remaining elements

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perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

### ***Response to Arguments***

7. Applicant's arguments, see the paper filed June 10, 2004, with respect to the rejection(s) of claim(s) 1 – 12 under Futey et al. in view of Tackikawa et al. and Martin have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the above stated prior art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

*4/28/05*